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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/086,180

Filing Date: February 25, 2002

Appellant(s): DAVIS, BRUCE L.

William Y. Conwell 31,943
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04/18/08 appealing from the Office action
mailed 03/30/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

As noted by applicant, an earlier appeal brief was filed 11/07/2005. However, at that time, the application was not forwarded to the BPAI and the prosecution was reopened in view of better prior art.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,760,916	DELLERT ET AL	6-1998
5,841,886	RHOADS	11-1998

Appellant's Remarks filed 05/02/2006 for this application. Specifically page 7.

Excerpt provided in the grounds of rejection.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims. The rejections have been clarified in relation to the reasoning for obviousness in order to simplify the examination of the issues on appeal. However, the grounds of rejection have not changed from the 03/30/07 Office action.

Claims 1-3, 5, 10, 11, 27 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,760,916 by Dellert et al. (Dellert).

With respect to Claims 1, 10 and 33, Dellert teaches a method of printing a trusted image, comprising:

an individual user electronically contacting an agency, soliciting an image depicting the user stored in an archive maintained by said agency (Col. 8 line 53 - Col. 9 line 6, Col. 9 lines 25-34 and Col. 1 lines 4-9: user electronically contacts hub station, which archives the users images, to request an image or images. The scope of photography and user's photographs would include images depicting the user).

electronically receiving said image from said contacted agency (Col. 9 lines 23-34);

printing a document incorporating said image (Col. 9 lines 23-49).

Dellert does not explicitly state the agency maintaining the archive is a governmental agency. However, as noted by Appellant (Page 7 of the 05/02/06 remarks filed by Appellant, see note below), one skilled in the art would recognize that an image archive is the same regardless of the entity maintaining the image archive. As

such, an agency maintaining the image archive as taught by Dellert would be the same as a governmental agency maintaining an image archive.

Based on this, it would have been obvious to one of ordinary skill in the art at the time the invention was made that to have the agency maintaining the image archive of Dellert be a government agency since the same functionality is achieved (again noting Page 7 of the 05/02/06 remarks filed by Appellant). Furthermore, Dellert shows it is desirable to allow users to remotely access images regardless of the type of agency storing those images (In Dellert: Col. 2 lines 11-27).

Note: For convenience, the pertinent section of Page 7 of Appellant's 05/02/06 remarks is as follows:

"As to the matter of technical enablement, the Action repeatedly focuses on the "government" aspect of the invention. However, an artisan would recognize that an image archive (e.g., database) is the same, whether it is maintained by a state DMV, or by Google. (Security protocols are familiar to artisans in all manners of databases, and compliance with any security protocols is a matter within the capability of an artisan in the field to which the invention relates.) The claimed "contacting, soliciting," "receiving," and "printing" are all acts within the technical capability of an artisan in the field to which the claims relate." (emphasis added)

With respect to Claim 2, Dellert further teaches it is the individual user who receives said image and prints said document (Col. 9 lines 23-34).

With respect to Claim 3, Dellert further teaches said document is a photo identification document (Col. 3 lines 23-49).

With respect to Claim 5, Dellert does not explicitly disclose the governmental agency is a motor vehicle licensing agency, and the image is a driver license photo.

However, as noted by Appellant (Page 7 of the 05/02/06 remarks filed by Appellant), one skilled in the art would recognize that an image archive is the same regardless of the entity maintaining the image archive. As such, the soliciting, receiving and printing would be performed the same regardless of the agency being a motor vehicle licensing agency and the image being a driver license photo.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the agency of Dellert be a motor vehicle licensing agency, and the image being a driver license photo since the same functionality is achieved.

With respect to Claim 11, Dellert teaches a method of distributing a trusted image, comprising:

at an agency, receiving an electronic request for an archived personal image from an individual depicted in said image(Col. 8 line 53 - Col. 9 line 6, Col. 9 lines 25-34 and Col. 1 lines 4-9: hub station, which archives the users personal images, electronically receives user request for an image to request an image or images. The scope of photography and user's photographs would include images depicting the user); electronically transmitting said image to said individual (Col. 9 lines 23-34).

Dellert does not explicitly state the agency is a governmental agency. However, as noted by Appellant (Page 7 of the 05/02/06 remarks filed by Appellant, see note below), one skilled in the art would recognize that an image archive is the same regardless of the entity maintaining the image archive. As such, an agency maintaining the image archive as taught by Dellert would be the same as a governmental agency maintaining an image archive.

Based on this, it would have been obvious to one of ordinary skill in the art at the time the invention was made that to have the agency maintaining the image archive of Dellert be a government agency since the same functionality is achieved (again noting Page 7 of the 05/02/06 remarks filed by Appellant). Furthermore, Dellert shows it is desirable to allow users to remotely access images regardless of the type of agency storing those images (In Dellert: Col. 2 lines 11-27).

With respect to Claim 27, Dellert teaches printing said document at a home of said individual user (Col. 9 lines 23-34).

Claims 4, 6-9, 12-15 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dellert in view of U.S. 5,841,886 by Rhoads (Rhoads).

With respect to Claim 4, Dellert does not explicitly disclose said document is an identification badge.

Rhoads teaches identification documents can include identification badges (Col. 1 lines 27-34 and Col. 6 lines 44-57).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Dellert and modify it as indicated by Rhoads such that said document is an identification badge. One would be motivated to have this as identification badges are desirable and widely used for identification purposes (In Rhoads: Col. 1 lines 27-34 and Col. 6 lines 44-57).

With respect to Claim 6, Dellert does not explicitly disclose said image is processed with an identification code by the governmental agency.

Rhoads teaches an image can be processed with an identification code (Col. 1 lines 46-67 and Col. 7 lines 30-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Dellert and modify it as indicated by Rhoads such that said image is processed with an identification code. One would be motivated to have this, as it enhances the security of photo identification documents (In Rhoads: Col. 7 lines 4-11).

With respect to Claim 7, Dellert teaches all the limitations of Claim 1, but does not explicitly disclose said image is digitally watermarked with a plural-bit code by the governmental agency.

Rhoads teaches an image can be digitally watermarked with a plural-bit code (Col. 1 lines 46-67 and Col. 7 lines 30-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Dellert and modify it as indicated by Rhoads such that said image is digitally watermarked with a plural-bit code by the

governmental agency. One would be motivated to have this, as it enhances the security of photo identification documents (In Rhoads: Col. 7 lines 4-11).

With respect to Claim 8, Dellert further teaches said plural bit code serves to identify the individual user's name (In Rhoads Col. 1 lines 46-67 and Col. 7 lines 30-54).

With respect to Claim 9, Dellert further teaches said plural-bit code comprises an index into a data structure in which the individual user's name is stored (In Rhoads Col. 1 lines 46-67 and Col. 7 lines 30-54).

With respect to Claim 12, Dellert teaches all the limitations of Claim 11, but does not explicitly disclose processing said image with an identification code prior to said electronic transmission.

Rhoads teaches an image can be processed with an identification code (Col. 1 lines 46-67 and Col. 7 lines 30-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Dellert and modify it as indicated by Rhoads such that said image is processed with an identification code prior to electronic transmission. One would be motivated to have this, as it enhances the security of photo identification documents (In Rhoads: Col. 7 lines 4-11).

With respect to Claim 13, Dellert teaches all the limitations of Claim 11, but does not explicitly disclose digitally watermarking said image with a plural-bit code prior to said electronic transmission.

Rhoads teaches an image can be digitally watermarked with a plural-bit code (Col. 1 lines 46-67 and Col. 7 lines 30-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Dellert and modify it as indicated by Rhoads such that said image is digitally watermarked with a plural-bit code prior to electronic transmission. One would be motivated to have this, as it enhances the security of photo identification documents (In Rhoads: Col. 7 lines 4-11).

With respect to Claim 14, Dellert further teaches said plural bit code serves to identify the individual user's name (In Rhoads Col. 1 lines 46-67 and Col. 7 lines 30-54).

With respect to Claim 15, Dellert further teaches said plural-bit code comprises an index into a data structure in which the individual user's name is stored (In Rhoads Col. 1 lines 46-67 and Col. 7 lines 30-54).

With respect to Claim 28, Dellert does not explicitly disclose obtaining from a database maintained by said governmental agency a name of said individual user, and printing said obtained name on the document.

Rhoads teaches obtaining from a database a name of said individual user and printing said obtained name on the document (In Rhoads Col. 1 lines 46-67 and Col. 7 lines 30-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Dellert and modify it as indicated by Rhoads such that it further comprises obtaining from a database maintained by said governmental agency a name of said individual user, and printing said obtained name on the document. One would be motivated to have this, as it enhances the security of photo identification documents (In Rhoads: Col. 7 lines 4-11).

(10) Response to Argument

Argument A-Claim 1

Appellant argues on pages 7-9 of the appeal brief under section 1:

"In contrast, image archives maintained by governmental agencies are not commercial repositories for images owned by consumers. The images are typically owned by the government. Nothing in Dellert would have led an artisan to grant consumer access to a governmental image archive.

Although hindsight may transform Dellert into the presently claimed method, it would not otherwise have been obvious to do so. Images from government archives - of the sort maintained by the US Department of State, or state motor vehicle departments, are not generally available for personal use. Absent a teaching otherwise, an artisan would not have considered such images to be available for non-governmental use. Absent hindsight, an artisan would not transform Dellert to yield the claimed invention. For this reason, the rejection should be reversed."

Examiner's Response to Argument A:

Appellant appears to be arguing that identifying the agency as being "governmental" imparts specific limitations upon the claimed invention. Particularly, it seems appellant is suggesting subject matter related to the access and use of the images should be considered in the scope of "governmental". However, in reviewing applicant's specification, the examiner could find no description/definition of "governmental" to support or suggest that certain access features must be considered in interpreting such language.

As such, it appears appellant is relying on features which are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, the examiner points to the remarks filed by appellant on 05/02/06 which was cited in the above rejection. Appellant specifically stated, *“However, an artisan would recognize that an image archive (e.g., database) is the same, whether it is maintained by a state DMV, or by Google.”* (see Page 7 of the 05/02/06 remarks). The examiner has based the interpretation of the claims on this statement by the appellant and has relied upon this statement as evidence of obviousness. It is unclear as to how appellant can state in one instance that an image archive would be the same regardless of the agency/entity maintaining the archive and then state that the use of “governmental” now indicates certain access features for the image archive.

Note also that the cited remarks were in fact a response to an enablement rejection where the examiner had considered the possibility that “governmental” implied certain access/security concerns and that the specification did not fully describe such access/security concerns to the point where one would be enabled to make/use the invention. However, based on appellant’s response, the examiner withdrew the enablement as appellant’s remarks above indicate that there were no such access/security concerns or features in relation to the interpretation of “governmental”.

Argument B - Claim 1

Appellant argues on pages 8-9 of the appeal brief under section 1:

"Reversal is also required because the Examiner's § 103 reasoning is based on legal error. The Examiner disregarded limitations expressed in the claim - asserting that language requiring a "governmental agency" are entitled to no patentable weight. Such limitations were dismissed as "descriptive, ..." "

Examiner's response to argument B:

The § 103 reasoning was intended to show that the "governmental" aspect is obvious based in part on appellant's own remarks indicating that an artisan would recognize that the image archive is the same regardless of the maintaining entity (i.e. there is no functional difference). As such, claim language was not ignored but rather shown to be obvious based on a reasoning drawn from the presented evidence. As noted in the rejections presented above, the examiner clarified this reasoning in the rejections to simplify the examination of the issues on appeal (the grounds of rejection have not changed).

Argument C - Claim 3

Appellant argues on pages 9-10 of the appeal brief under section 4:

" *The Final Rejection states, "With respect to claim 3, Dellert further teaches said document is a photo identification document (Col. 3 lines 23-49)." Not so. Dellert has no teaching of a photo identification document.*"

Examiner's response to Argument C:

In Dellert, Col. 1, lines 4-9, the examiner interprets the scope of photography and user's photographs would be any images including images depicting the user. As such, the images of Dellert's invention described in col. 3, lines 23-49, would include in scope images depicting the user. A photograph is by nature an identification document of the image it is depicting. The claimed subject matter does not indicate any specific details or formatting required other than photo identification.

Argument D - Claim 5

Appellant argues on pages 10-12 of the appeal brief under section 5:

"As noted above, "descriptiveness" is not a ground for ignoring language found in the claim. All claim limitations necessarily are descriptive - they serve to describe the claimed invention."

Examiner's response to Argument D:

As discussed in the response to Argument B, the intent of the grounds of rejection is to show that certain claimed subject matter is obvious in view of the evidence stated by the Appellant (Appellants remarks discussed above and the scope of the claim language based on the specification as discussed in the response to Argument A). As such, claim language was not ignored but rather shown to be obvious based on a reasoning drawn from the presented evidence. As noted in the rejections presented above, the examiner clarified this reasoning in the rejections to simplify the examination of the issues on appeal (the case law as rationale for obviousness was removed, however the grounds of rejection have not changed).

Argument E - Claim 4

Appellant argues on page 13 of the appeal brief under section 9:

“While it is true that identification badges are desirable and widely used for identification purposes, the rejection is silent as to why such teaching would have been combined with Dellert’s online photo ordering method. The rejection makes an unexplained leap. It lacks the “articulated reasoning with some rational underpinning” required by KSR. The rejection should be reversed.”

Examiner’s response to Argument E:

Rhoads specifically discusses the use of identification badges which are created in part through the printing of images of the bearer. As shown in the rejection and discussion above, Dellert is drawn to the field of images/photograph and the printing of such images. Clearly then, there is not an “unexplained leap” to the idea of printing images for the purpose of identification badges. The examiner further provides a rationale of desire and wide use of identification badge and notes that appellant agrees with this statement. Therefore, the examiner believes that a proper *prima facie* case of obviousness has been established based on the teachings and rationale provided.

Argument F - Claim 6

Appellant argues on page 14 of the appeal brief under section 10:

"While Rhoads enhances the security of photo identification documents, the Office again focuses on photo identification documents without any mention of same in Dellert - which concerns online photo ordering. Again, the rejection makes an unexplained leap - lacking the "articulated reasoning with some rational underpinning" required by KSR. Again, the Final Rejection has not established prima facie obviousness."

Examiner's response to Argument F:

Dellert also is concerned with the printing of photographs. As identification documents are also concerned with a printed photograph depicting the bearer, the rejection is not making an unexplained leap. The examiner further provides a rationale of enhanced security. MPEP 2144, section II, indicates the strongest rationale for combining references is a recognition that some advantage would be produced. The examiner has provided such a rationale.

Argument G - Claim 28

Appellant argues on pages 14-15 under section 12:

" *One is that - as with claim 6 - the Office has turned to Rhoads without any "articulated reasoning with some rational underpinning" for doing so.*

A second reason is that the Office has mis-read Rhoads. The Final Rejection states:

Rhoads teaches obtaining from a database a name of said individual user and printing said obtained name on the document (In Rhoads Col. 1 lines 46-67 and Col. 7 lines 30-54).

However, the cited passages do not teach the required claim limitations."

Examiner's response to Argument G:

The examiner relies on the response to Argument F (claim 6) to address appellant's first reason.

In regards to Appellant's second reason, the examiner disagrees as Rhoads specifically states in part "*An illustrative embodiment of the present invention is a method of correlating, with a photograph, information about an individual whose image appears in the photograph.*" Rhoads further states in regards to this information "*The multi-bit data can serve various purpose (e.g. identify an owner of the photograph*", in other words, the name of the individual user. The examiner believes this is within the scope of the claim language as the claim does not specifically indicate the format of printing the name.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/David Lazaro/

Patent Examiner 2155

Conferees:

/saleh najjar/

Supervisory Patent Examiner, Art Unit 2155

/Ario Etienne/

Supervisory Patent Examiner, Art Unit 2157